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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,326	10/16/2001	James J. Xu	19763/82069	4458

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EXAMINER	
BISSETT, MELANIE D	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/978,326	XU, JAMES J.	
	Examiner	Art Unit	
	Melanie D. Bissett	1711	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *12 July 2004*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☒ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☒ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Continuation of 2. NOTE: Independent claims 21 and 39 have been amended to recite ranges of "about 75 mole percent" and "about 25 mole percent". However, the applicant has not shown how the specification supports mole percentages slightly below 75 mole % or slightly above 25 mole %. It is the examiner's position that the specification does not support such approximate ranges. In the event that the proposed amendment is entered, the examiner maintains her position on the rejections based on 35 USC 103.

In response to the applicant's arguments that Koerner et al. does not teach the claimed molar ratios, the examiner has specifically pointed to passages in the reference that support amounts within the claimed range. Where the applicant argues that the reference teaches 50-90 mole percent of a tricarboxylic acid component, it is noted that the examiner has pointed to the passage that teaches the use of 10-50 mole percent of dicarboxylic acid and 50-90 mole percent of tricarboxylic acid anhydride. Examples show the use of adipic acid and trimellitic anhdydride as these components. Although the applicant argues that the recitation of a single species within the range does no suggest the range, it is noted that a claim is not patentable over a reference that teaches values within a claimed range. The examiner has shown how the reference teaches the claimed acid, anhydride, and diisocyanate components in the claimed amounts; thus, the rejections are maintained. In response to the applicant's arguments that the secondary reference does not teach the claimed ranges, it is noted that the primary reference teaches ranges which overlap the claimed ranges. In response to the applicant's arguments that one would not be motivated to improve the coatings of Koerner et al., it is the examiner's position that persons skilled in the art often consider methods of further improving materials. The secondary reference teaches motivation for including particulate additives; thus, one skilled in the art would be motivated to further improve coatings using this knowledge.

In response to the applicant's arguments that one would not be motivated to use the acid and anhydride components of Waki's invention in the claimed amounts, the applicant notes that the reference teaches using at least 40 mol% of trimellitic acid or anhydride. This would suggest to one skilled in the art to include larger amounts of TMA. Although the reference teaches a preferred use of at least 5 mol% of citric acid, the reference also teaches that an excess of 5 mol% may be included. Thus, the compositions may potentially comprise 100 mol% of TMA and 5 mol% of citric acid. The claims only require that the sum of the claimed compounds be "substantially the molar equivalent of the amount of the diisocyanate" and do not exclude citric acid. Note also that the term "substantially the molar equivalent" should be read by the broadest interpretation. The reference teaches high ratios of TMA to citric acid (examples 5 and 10-13). The reference also teaches the reasons for altering the amounts of each component, as the examiner has pointed out. Thus, it has been the examiner's position that it would have been obvious to modify the amounts of the components and arrive at the applicant's claimed ranges.

Continuation of 5. does NOT place the application in condition for allowance because: it does not serve to predate the references used t reject the independent claims. Also, although the rejections using Yin et al. would be withdrawn, other references support the conventionality of an addition of mineral particulates to a wire coating composition. See Yin et al. (US 6,180,888), which teaches the conventionality of including silica and TiO2 fillers in insulative wire coatings, including polyamide-imide.

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700